

03-12-03

AF 3742

Serial No. 09/739,990

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PATENT

57165-5019



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

CHANG et al.

Serial No. 09/739,990

Filed: December 18, 2000

For: HANDY ELECTRIC SEALER
WITH SAFETY MEANS

Group Art Unit: 3742

Examiner: Van, Q.

CERTIFICATE OF MAILING

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REPLY TO EXAMINER'S ANSWER

RECEIVED

The Assistant Commissioner for Patents
Washington, D.C. 20231

MAR 17 2003

TECHNOLOGY CENTER R3700

Sir:

This is a reply to the Examiner's answer mailed on January 8, 2003, in an appeal from the decision dated January 24, 2002, finally rejecting claim 44 under 35 U.S.C. §103(a) as being unpatentable over Chou, U.S. Patent 5,142,123 (hereinafter "Chou '123"), in view of Netherlands Patent 542,359 (hereinafter "Netherlands '359") and Taiwanese Patent No. 040,687 (hereinafter "Taiwanese '687").

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Noted
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ARGUMENT

I. The Examiner still has not provided motivation to combine the Chou '123, Netherlands '359 and Taiwanese '687 references.

5 As Appellant has previously stated, the Examiner has not cited any reason nor motivation to combine the references, but merely asserted that the combination would be obvious to one of ordinary skill in the art. In the Examiner's Answer, the Examiner does not correct this defect,
10 but only attempts to note why the references do not teach away from the improper combination.

 Although the Examiner first states that the Examiner "recognizes that references cannot be arbitrarily combined and there must be some reason why one skilled in the
15 art would be motivated to make the proposed combination of primary and secondary references,"¹ the Examiner then relies on In re Bozek,² for the proposition that "references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures."³

20 It is well settled that the mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the

¹ Id. at 7.

² In re Bozek, 163 USPQ 545 (C.C.P.A. 1969)

³ Examiner's Answer at 7.

desirability of the modification.⁴ The "common knowledge and common sense" approach to prior art analysis presented by the Examiner is improper and has been specifically rejected by decisions such as In re Lee, where it is noted that "Bozek,
5 after thirty-two years of isolation . . . , [does not] outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence."⁵

Appellant maintains that the Examiner has not met
10 the burden of establishing a *prima facie* case of obviousness in that the Examiner has not provided evidence that there is a motivation to combine the references, nor has the Examiner shown that the combined references teaches or suggests the claim limitations.

15 II. Appellant has not "merely rearranged parts" but has created a novel and unobvious switching and biasing mechanism.

The Examiner, in his answer to Appellant's brief on appeal, has maintained that "it has been held that
20 rearranging parts of an invention only involves routine skill in the art. In re Japikse, 86 USPQ 70."⁶ However, upon a review of that case, it is quite clear that the holding of

⁴ In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984), and cases cited therein.

⁵ See In re Lee, 61 USPQ 1430, 1435 (Fed. Cir. 2002).

Japikse is limited to the particular facts of the case--i.e., the position of the starting switch is immaterial and, therefore, obvious, since the overall operation of the device would not be affected by such change.

5 In the present case, the Examiner has not established that the same could be said for the metal press plate and switch in Appellant's sealer, which eliminates the need to activate/deactivate a separate switch and which provides a biasing mechanism. In fact, Appellant notes that
10 if Appellant's switch or metal press plate (i.e., the biasing mechanism) were placed apart from each other, then the operation of the device would be completely different. Thus, it is submitted that Appellant has not simply "rearranged" some parts as the overall operation of the device is affected
15 by Appellant's invention.

III. Even assuming the combination of Chou '123, Netherlands '359 and Taiwanese '687 is proper, the combined references neither teach nor suggest the combination as taught by appellant.

20 Appellant has previously stated that benefits of the interaction of the press bar, the metal press plate, and the switch is achieved by more than just a rearrangement of a part (i.e., the metal press plate), as the operation of the

⁶ Examiner's Answer at 5.

device is modified if the parts are not in Appellant's
claimed arrangement.

However, in the Examiner's Answer, the Examiner has
attempted to limit the issue to the "moving of the mounting
5 plate" in Taiwanese '687 from the base to the press bar.'

This ignores the teachings of Taiwanese '687, which includes
the incorporation a switch 23 and baffle 13 that is separate
from the press plate and requires the switching of a separate
mechanism (i.e., switch 23) to allow activation of the sealer.
10 Appellant has not simply "moved" a part from the base to the
press bar, but instead, has created a configuration that does
not require a user to activate a separate switch before a
sealer can be used when the press bar is pressed towards the
base.

15 It is believed that the above statements
demonstrate that the cited reference(s) do not render obvious
the presently claimed invention as required by 35 U.S.C. §103.
Absent an adequate teaching in the reference(s), this
rejection cannot stand and should be reversed.

20 CONCLUSION

Appellant continues to submit that the Examiner has
failed to make a *prima facie* case of obviousness in that the
Examiner has still not provided any evidence of the

motivation for the proposed combination of Chou '123,
Netherlands '359 and Taiwanese '687. In addition, Appellant
has further shown that, even if the proposed combination is
proper, it fails to suggest to one of ordinary skill in the
5 art to provide the claimed invention. In the absence of such
a suggestion, the subject matter of the claims at issue
cannot be considered obvious under 35 U.S.C. §103.

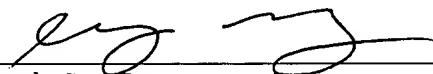
For the foregoing reasons, it is submitted that the
final rejection is not in accordance with the Patent Statute
10 and Appellant respectfully requests that it be reversed.

Respectfully submitted,

Date:

3/10/03

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⁷ See Examiner's Answer at 8 ("rearranging parts means reverse mounting of the press plate").